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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,374	08/08/2007	Torsten Ziser	CH-8232/RC-235	2733

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EXAMINER

WANG, CHUN CHENG

ART UNIT	PAPER NUMBER
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4171

MAIL DATE	DELIVERY MODE
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08/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,374	Applicant(s) ZISER ET AL.	
	Examiner Chun-Cheng Wang	Art Unit 4171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6 and 36 is/are rejected.
- 7) ☒ Claim(s) 4, 7-35 and 37-39 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/24/2006 and 07/24/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Co-pending Double Patenting

1. Claims 1 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 and 3 of copending Application No. 10/947876. Although the conflicting claims are not identical, they are not patentably distinct from each other because the viscosity range of the instant application is broader than that of the co-pending application claimed range.
2. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

3. Claims 4, 7-35 and 37-39 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 3. See MPEP § 608.01(n). Accordingly, the claims 4, 7-35 and 37-39 are not been further treated on the merits.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 36 provides for the use of microgels as a rheological additive, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 36 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e.,

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results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5-6 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Lavoie et al. (US 5331025).

8. Regarding claims 1-3: Applicants recite composition comprising at least one non-crosslinkable organic medium (A) which has a viscosity of less than 30,000 mPas at a temperature of 120°C and at least one microgel (B) (claim 1), wherein the non-crosslinkable organic medium (A) has a viscosity of less than 1000 mPas at a temperature of 120°C (claim 2), wherein the non-crosslinkable organic medium (A) has a viscosity of less than 200 mPas at a temperature of 120°C (claim 3).

9. Lavoie et al. disclose coating compositions containing a film-forming resin, a volatile organic liquid, which is a solvent for the film-forming resin and composite polymer particles, reads on microgel (B) in claim 1 (column 4, lines 31-34). The volatile organic liquid of the composition may be any of the liquids, or mixtures of liquids, that are conventionally used as polymer solvents in coating compositions including aromatic hydrocarbons such as toluene and xylene, reads on claim 1, 2 and 3 non-crosslinkable organic medium (A) which has a viscosity of less than 30,000, 1,000 and 200 mPas respectively at a temperature of 120°C, and petroleum fractions of various boiling ranges having a significant aromatic content; aliphatic hydrocarbons such as mineral spirits; esters such as butyl acetate, ethylene glycol diacetate, and 2-ethoxyethyl

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acetate; ketones such as acetone and methyl isobutyl ketone; and alcohols such as butyl alcohol (column 5, lines 60-68 and column 6, line 1).

10. Regarding claims 5-6: Applicants recite composition according to claims 1 or 4, characterized in that the deviation of the diameters of an individual primary particle of the microgel (B), defined as $[(d1-d2)/d2] \times 100$, wherein d1 and d2 are any two desired diameters of the primary particle and d1 is $>d2$, is less than 250% (claim 5), wherein the said deviation is less than 50% (claim 6).

11. Lavoie et al. disclose the particle size of the composite polymer particles is typically in the range from about 100 nanometers to about 550 nanometers (nm), preferably from about 250 nm to about 500 nm (column 7, lines 24-27), which has deviation of the diameters of an individual primary particle of the microgel (B) of 100. Lavoie et al. also disclose composite polymer particles size of 350-400 nm (column 15, Table 1.2), which has deviation of the diameters of an individual primary particle of the microgel (B) of 15.

12. Regarding claim 36: Applicants recite Use of microgels as a rheological additive, in particular as a thickener or thixotropic agent, in non-crosslinkable organic media which have a viscosity of less than 30,000 mPas at a temperature of 120°C.

13. Lavoie et al. disclose first stage polymer may be crosslinked by incorporating a polyfunctional monomer into the polymer. The amount of polyfunctional monomer used in the first stage polymer is determined in part by the need to optimize rheological and mechanical properties of the coating composition in which the composite polymer particle is ultimately used (column 7, lines 59-65).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chun-Cheng Wang whose telephone number is (571)270-5459. The examiner can normally be reached on Monday to Friday w/alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit 4171

Chun-Cheng Wang
Examiner, Art Unit 4171

/CCW/